UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/302,552	04/30/1999	STEPHEN SAVITZKY	15358-46	7040

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EXAMINER
NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)
Office Action Summary		09/302,552	SAVITZKY ET AL.
		Examiner	Art Unit
		Maikhanh Nguyen	2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 December 2004*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *04/08/2004*.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

DETAILED ACTION

1.   This action is responsive to communications: 12/20/2004 to the original application filed

04/30/1999.

2.   Claims 1-13 are currently pending in this application. Claims 1 and 9 are independent

claims.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1-3 and 6-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over

MacPhail (U.S. 5,179,718 – issued 01/1993, as cited by Applicant's IDS filed

04/08/2004) in view of **Khan et al.** (U.S. 6,401,206 – filed 03/1998), as previously cited.

As to independent claim 1:

a.   McPhail teaches in an electronic document handling system, a method of

manipulating documents *(Abstract)* comprising the steps of:

(i)   generating a staple data object, for representing an association of selected

pages and selected documents *(e.g., establishing a staple relationship*

between two documents;; Abstract/ combining documents together in a

staple relationship within a context of a folder; col.2, lines 58-60/ col.3,

lines 45-53 and col.8, lines 7-10);

(ii)   generating an electronic cover sheet for the staple data object (e.g., The

system then maintains the staple relationship between the identified

documents within the context of the specified folder document; Abstract);

(iii)   accepting from a user a list of at least one page of at least one electronic

document (e.g., An end user indicates to the system that a staple

relationship is to be created between at least two identified documents

stored in therein; col.2, lines 61-63/ col.3, lines 1-10 and col.4, lines 50-

55);

(iv)   referencing each page or each electronic document in the list as an item of

the staple data object (e.g., The staple relationship is then defined by

entering an indication that the staple relationship is restricted to the

context of the folder document ...pointers to the physical locations of the

at least two documents in the system; col.2, lines 63- col3, line 2);

(v)   accepting a staple instruction from a user (e.g., the server files the

identified documents into the library as specified by the staple relationship

defined by the end user; col.3, lines 8-10 and lines 45-59); and

(vi)   securing the data object in response to receipt of the staple instruction,

thereby indicating the integrity of the association of selected pages and

selected documents together at one time (col.4, lines 59-68).

b.   McPhail does not specifically teach the use of crytography.

c.   Khan teaches the use of cryptography *(e.g., cryptographic; Abstract and col.11,*
        lines 23-34).

d.   It would have been obvious to one of ordinary skill in the art at the time the
        invention was made to include the feature from Khan in the system of McPhail
        because it would have provided the capability for establishing the integrity of the
        document, and ensures non-repudiation of origin to the extent that is was signed
        by the user's private key.

As to dependent claim 2:

MacPhail teaches accepting a manually input list *(col.4, lines 39-55).*

As to dependent claim 3:

McPhail teaches accepting a computer-generated list *(col.4, lines 39-55)*

As to dependent claim 6:

McPhail teaches copying the selected pages and selected documents in a stack to static
storage *(col.3, lines 60-67).*

As to dependent claim 7:

MacPhail teaches copying the selected pages and selected documents in a stack to a local
storage device local to the electronic document handling system *(col.3, line 60-col.4, line
12).*

As to dependent claim 8:

MacPhail teaches displaying a first list of documents, wherein the first list of documents
lists the documents that are selected for inclusion in an open stack; displaying a second

list of document, wherein the second list of documents list documents that have not been

selected for inclusion in an open stack; and displaying a user interface control operative

to obtain selections from a user of documents from the second list for inclusion in an

open stack *(col.4, lines 13-38).*

As to independent claim 9:

The rejection of independent claim 1 above is incorporated herein in full. Additionally,

McPhail further teaches:

(i)   opening a secured stack upon receipt of a stack open instruction *(e.g., a EU can*

         ask the system 10 to search for all documents regarding a particular subject and

         by a certain author which was filed in the library; col.4, lines 46-59);

(ii)   presenting the contents of the secured stack for perusal by the user *(e.g., the*

         system presents the EU with a list of the documents which meet the search

         criteria; col.4, lines 50-52);

(iii)   accepting additions and deletions of items on the secured stack *(e.g., delete*

         documents from the library; col.4, lines 57-58 and col.6, lines 15-19); and

(iv)   securing the secure stack upon receipt of a stack restaple operation *(e.g., allow*

         authorized end users other than the EU who filed the document to retrieve the

         document from the library and perform searches for and retrieve documents in

         the library for other end user; col.4,lines 60-67).

As to dependent claim 10:

MacPhail teaches using a stack signature to secure the stack object, wherein the stack

signature is a checksum of the contents of all the selected pages and selected documents

in the stack, signed by the digital signature of a user or the digital signature or private key

of a system *(col.4, lines 59-64).*

As to dependent claim 11:

MacPhail teaches storing the electronic cover sheet in a stack database, where it can be

referenced *(col.8, lines 32-37).*

As to dependent claim 12:

MacPhail teaches generating controls for adding and deleting selected pages and selected

documents from the stack *(e.g., An access control model object; col.5, lines 23-25 and*

Fig.2).

As to dependent claim 13:

a.   MacPhail teaches the electronic cover sheet includes a visual indication that the

existence of the association of selected pages and selected documents together at

one time *(e.g., relationship is to be created between at least two identified*

documents; col.2, lines 1-67/ establish the staple relationship between a pair

documents; col.3, lines 45-54).

b.   Refer to discussion of claim 1 above for rejection of "crytopgraphically

securing."

5.   Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over **MacPhail** in

view of **Khan et al.** as applied to claim 1 above, and further in view of **IBM** "Technical

Disclosure Bulletin" (issued 07/1992).

As to dependent claim 4:

a.   The combination of MacPhail and Khan does not specifically teach "presenting a user with an online form as an aid to selecting pages or documents for association as a stack."

b.   IBM teaches presenting a user with an online form as an aid to selecting pages or documents for association as a stack *(e.g., on-line documents ... the need for an on-line stapler; page 1)*.

c.   It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine IBM's teachings in the system of MacPhail as modified by Khan because it would have provided the capability for quickly and easily associating on-line, soft copy documents to another.

As to dependent claim 5:

a.   The combination of MacPhail and Khan does not specifically teach "prompting for the staple instruction by presenting the user with a stapler icon which, when selected, represents the staple instruction."

b.   IBM teaches prompting for the staple instruction by presenting the user with a stapler icon which, when selected, represents the staple instruction *(e.g., a small stapler icon ... The user selects the stapler icons; page 1)*.

c.   It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine IBM's teachings in the system of MacPhail as modified by Khan because it would have provided the capability for quickly and easily associating on-line, soft copy documents to another.

Response to Arguments

6.   Applicant's arguments filed 12/20/2004 have been fully considered but they are not

persuasive.

   a.   Applicant argues *that there is nothing in MacPhail discloses or suggests that this*

          security level can deter or detect document tampering by an otherwise authorized

          user, or event that document integrity is a concern. (Remarks, page 8, 1st full

          para.)

   b.   In response, the feature *"deter or detect document tampering by an otherwise*

          authorized user" is not claimed. Applicant is arguing the disclosure of the

          invention, not the claimed limitations. Claimed subject matter, not the

          specification is the measure of the invention. Limitations in the specification

          cannot be read into the claims for the purpose of avoiding the prior art. See In re

          Self, 213 USPQ 1,5 (CCPA 1982); In re Priest, 199 USPQ 11, 15 (CCPA 1978).

          The Examiner has a *duty* and *responsibility* to the public and to Applicant to

          interpret the claims *as broadly as reasonably possible* during prosecution (see *In*

          re Prater, 56 CCPA 1381, 415 F.2d 1393, 162 USPQ 541 (1969).

   c.   Applicant argues *that there is nothing in MacPhail or otherwise in the art that*

          discloses or suggest "cryptographically security the staple data object."

          (Remarks, page 6, last para.)

   d.   In response, MacPhail teaches securing the staple data object (specifying a

          security level to associate with the document; col.4, lines 59-680, and Khan

teaches crytopgraphic *(e.g., cryptographic; Abstract and col.11, lines 23-34).*

Accordingly, the combination of MacPhail and Khan meets the claimed

limitations as claimed by Applicant.

Conclusion

7.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-

4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30

pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph H Feild can be reached on (571) 272-4090.

The fax phone number for the organization where this application or proceeding is

assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For

more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free).

JOSEPH FEILD
SUPERVISORY PATENT EXAMINER

Maikhanh Nguyen
April 20, 2005